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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,808	01/26/2001	Michael M. Segal	2008836-0005 (SIM-005)	8253
24280 7590 06/24/2009 CHOATE, HALL & STEWART LLP TWO INTERNATIONAL PLACE BOSTON, MA 02110				
EXAMINER AKINTOLA, OLABODE				
ART UNIT 3691		PAPER NUMBER		
NOTIFICATION DATE 06/24/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@choate.com

### Office Action Summary

**Application No.**

09/770,808

**Applicant(s)**

SEGAL, MICHAEL M.

**Examiner**

OLABODE AKINTOLA

**Art Unit**

3691

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 4, 6-14, 16 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-14, 16 and 19-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/30/2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 5-7, 10-11, 14, 18-20, 23-24 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard (US 6182050) in view of Coli et al (US 6018713)..

Re claims 1, 3-4, 14, 16 and 27-31: Ballard teaches a method, computer readable medium and system for directing content to an end user's computer located within a network, comprising: a data collection module for gathering information about a *person* and for storing the information within a protective zone located within the end user's computer and isolated from third parties (col. 2, lines 23-25 and 57-60, col. 12, lines 28-40); a data content module for maintaining the identities of available third party data content wherein said identities contain parameters corresponding to said available third party data content (col. 12, lines 41-60); a correlation module for correlating said gathered information with said available data content to produce a set of content corresponding to said gathered information, and for directing said content to said end user (col. 12, lines 41-61).

Ballard does not explicitly teach a patient diagnostic tool; wherein said gathered information pertains to medical information using the patient diagnostic tool, wherein the end user is a health care provider and said *person* is a patient; and wherein said diagnostic tool interfaces with said data collection module to assist in gathering information about a patient.

Coli teaches information pertaining to medical information; wherein the end user is a health care provider and said person is a patient; and a diagnostic tool which interfaces with said data collection module to assist in gathering information about a person (col. 3, lines 16-20, 62-67, col. 4, lines 36-41, col. 5, lines 46-56, col. 16, lines 40-67, fig. 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ballard to include these features as taught by Coli. One would have been motivated to do so in order to apply Ballard's

teachings to the medical field whereby the information gathered about a patient by physicians can be used for directing targeted content.

Re claims 6-7 and 19-20: Ballard teaches that the data collection module, data content module and the correlation module reside within the end user's computer (col. 2, lines 23-25 and 57-60, col. 12, lines 28-40).

Re claims 10-11 and 23-24: Ballard teaches wherein said data collection module resides within said end user's computer and wherein said data content module and said correlation module reside within a network server (col. 8, line 63 through col. 9, line 27).

Claims 8, 12, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard in view of Coli in view of Lotspiech et al (US 6345289).

Re claims 8, 12, 21 and 25: Ballard teaches wherein the user's computer forwards a request to a network server. Ballard does not explicitly teach that the network server delivers said request to a third party server and said third party server then delivers the requested content to said user's computer in response to said request. Lotspiech teaches these limitations at col. 6, line 54 through col. 8, line 57). It would have been obvious to one of ordinary skill in the art at the time

of the invention to modify Ballard to include these steps as taught by Lotspiech. One would have been motivated to do so in order to enhance system functionality such that the third party can assume some of the routing functionality of the system.

Claims 9, 13, 22 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard in view of Coli in view of Shkedi et al (US 6973436)/Eldering et al (US 6457010)

Re claims 9, 13, 22 and 26: Ballard teaches wherein said end user's computer forwards a request for said content to said network server. Ballard does not explicitly teach, said network server delivers said request to a third party server which contains said content, said third party server then delivers said requested content to said network server in response to said request and then said network server forwards said delivered content to said end user's computer.

Shkedi teaches said network server delivers said request to a third party server which contains said content, said third party server then delivers said requested content to said network server in response to said request and then said network server forwards said delivered content to said end user's computer (Shkedi: col. 20, line 64 through col. 21, line 7; Eldering: Fig. 18, col.14, line 52 through col. 15, line 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ballard to include these steps as taught by Shkedi/Eldering. One would have been motivated to do so in order to enhance system functionality such that the transfer of advertisement can be effected either directly from the content provider or via an intermediary (proxy technique).

### ***Response to Arguments***

Applicant's arguments filed 3/30/2009 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the difference between the Ballard system and the instant application is analogous to the difference methods used by DoubleClick and Google (See Remarks, Pg 8)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Coli explicitly teaches targeted advertising based on medical history (col. 16, lines 40-67, fig. 15).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reilly et al (US 5740549) teaches the data collection module, data content module and the correlation module reside within the end user's computer (Abstract, Fig. 12)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/O.A/  
Examiner, Art Unit 3691

/Hani M. Kazimi/  
Primary Examiner, Art Unit 3691